## REMARKS

Claims 1-3 are pending in the application

Claims 1-3 were rejected

## I. 35 USC §103 Claim Rejections

Claims 1-3 were rejected under 35 USC §103(a) as being unpatentable over Davis *et al.* (U.S. Pub. No. 2004/0181419) in view of Garrett (U.S. Pub. No. 2004/0042565) and further in view of Chan *et al.* ("A Simple Taboo-Based Soft Decision Decoding Algorithm For Expander Codes," IEEE Communications Letters, Vol. 2, No. 7, pp. 183-185, July 1998). Applicant herein traverses this rejection basis and respectfully requests reconsideration thereof.

It is first noted that both the primary reference and the first-cited of the secondary references are the inventors own work. More important, the primary reference, Davis, is not prior art to this invention, being the inventors own work and being published subsequent to the filing date of the application herein. It is also noted that both the invention herein and the invention of the Davis reference are commonly assigned to Lucent Technologies, and accordingly, pursuant to 35 USC §103(g), the Davis reference cannot be applied to preclude patentability even in the event the Davis reference were construed to be the work of another, due to additional inventors (beyond the inventor here) being party to that application. Accordingly, the primary §103 reference having been shown to fail as a basis for the rejection, the rejection itself must fail.

In addition, it is respectfully submitted that, even if the cited prior works of the inventor were construed to teach each of the relevant components of the invention here, there has been no showing of a motivation to combine those references in the manner of the invention here. Indeed, there is no recognition whatsoever in those references of the problem addressed by the invention of the present application. Thus, the rejection here becomes a classic "hindsight" rejection -- *using the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention* – an approach consistently rejected by the courts. See *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998):

> Virtually all inventions are combinations of old elements [*citations omitted*]. Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability.
>
> To prevent the use of hindsight based on the invention to defeat patentability out the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge out of claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

The Applicant accordingly submits that the §103 rejection of the present office action cannot stand. Withdrawal of that rejection is respectfully requested.

## II. Conclusion

In view of the foregoing, allowance of all the claims presently in the application is respectfully requested, as is passage to issuance of the application. If the Examiner should feel that the application is not yet in a condition for allowance and that a telephone interview would be useful, he is invited to contact Applicants' undersigned attorney at (973) 386-4237.

Respectfully submitted,

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